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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/537,940 | 06/07/2005 | Jurg Haase | HU/1-22812/A/PCT | 6888 |

324 7590 11/15/2006

CIBA SPECIALTY CHEMICALS CORPORATION
PATENT DEPARTMENT
540 WHITE PLAINS RD
P O BOX 2005
TARRYTOWN, NY 10591-9005

EXAMINER

NOLAN, JASON MICHAEL

ART UNIT PAPER NUMBER

1626

DATE MAILED: 11/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-----------------------------------|------------------------------|--|
| Office Action Summary | Application No. 10/537,940 | Applicant(s) HAASE ET AL. | |
| | Examiner Jason M. Nolan, Ph.D. | Art Unit 1626 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23, 26, 27, 29 and 30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 27 is/are allowed.
- 6) ☒ Claim(s) 1-5, 26, 29 and 30 is/are rejected.
- 7) ☒ Claim(s) 6-23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>9/8/2005</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-23, 26, 27 & 29-30 are currently pending in the instant application; of which: **Claims 1-7, 12, 14, 16-17, 22-23, 27 & 29** have been amended, **Claims 24, 25 & 28** are cancelled, and **Claim 30** is new.

Priority

This application is a 371 of PCT/EP03/50937, filed on 12/03/2003. Receipt of 024060931, filed on 12/12/2002 in Europe (EPO), 3003 111303, filed on 6/25/2003 in Switzerland, and 031022973, filed on 7/25/2003 in Europe (EPO) submitted under 35 U.S.C. §§ 119(a)-(d) is acknowledged; which papers have been placed of record in the file. Claim for priority in the oath is acknowledged.

Information Disclosure Statement

Applicants' information disclosure statement (IDS), filed on September 8, 2005 has been considered. Please refer to Applicants' copy of the 1449 submitted herein.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 26, 29 & 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Habeck *et al.* (US 6,409,995, 6/25/2002, see IDS). The patent discloses several cosmetic formulations comprised of compounds that read on said claims and can be found in columns 5-9 of the '995 patent: wherein R^5 = cyclohexyl (this reads on the instant claims wherein n_1 is 1, **A** is O, and **R**₃ is cyclohexyl; this applies to when **R**₁ and **R**₂ are H, alkyl, cycloalkyl, or form a ring together). Further, Claims 1 & 7 of the '995 patent disclose compounds which read on the instant application, wherein **A** is N(**R**₅) and **R**₅ is hydrogen or C₁-C₅-alkyl.

Claim Objections

Claim 5 is objected to because of the following informalities: each claim must end with a period. Appropriate correction is required.

Claim 22 is objected to because of the following informalities: the term "dehydratisating" is unknown and not defined in the specification. Appropriate correction is required.

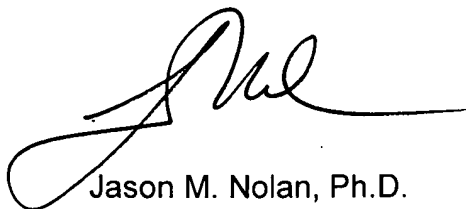
Claim 23 is objected to because of the following informalities: the structure of formula (7) does not have a nitrogen atom between **R**₁ and **R**₂. Appropriate correction is required.

Claims 6-21 are objected to as being dependent upon a rejected base claim.

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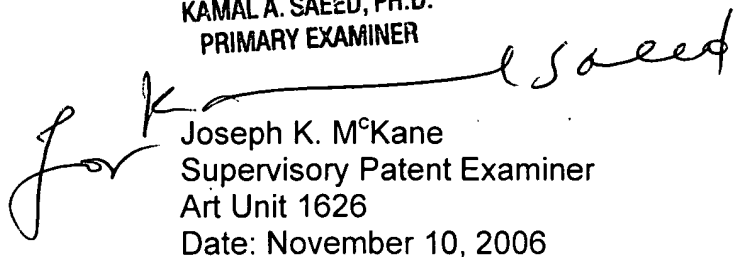
Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jason M. Nolan, Ph.D.** whose telephone number is **(571) 272-4356** and electronic mail is **Jason.Nolan@uspto.gov**. The examiner can normally be reached on Mon - Fri (9:00 - 5:30PM). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Joseph M^cKane** can be reached on **(571) 272-0699**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jason M. Nolan, Ph.D.
Examiner
Art Unit 1626

KAMAL A. SAEED, PH.D.
PRIMARY EXAMINER



Joseph K. M^cKane
Supervisory Patent Examiner
Art Unit 1626
Date: November 10, 2006